

**REMARKS**

**Status of the Application**

Claims 1-25 have been examined in the current application. Applicant respectfully requests that the Examiner acknowledge Applicant's claim to foreign priority under 35 U.S.C. § 119, and receipt of the priority document filed February 19, 2004.

By this Amendment, Applicants are amended claims 1-25 to improve clarity. No new matter has been added.

**Claim Rejections - 35 USC § 112**

*Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the enablement requirement.*

The Examiner asserts:

This claim limitation requires that calling user initiates a call to a called user through a switch or server which determines identifiers of calling and called user terminals and then select the best terminals to satisfy call request in accordance with at least one availability criterion. This presupposes two stage process: first phase is used to first find out identifies of the calling and called terminals to satisfy some availability criterion for the call; second phase server/or switch after determining identifiers of the calling and called terminals which satisfy the availability criterion for the call, should initiate call to calling terminal and called terminal identified in the first phase and connect the call.

The Examiner also concludes, "Applicant's specification does not disclose this or it is not clear from applicant's disclosure how this is accomplished". Applicant respectfully disagrees with the Examiner's position.

Applicant respectfully submits that it is clear from the specification how the "device for the management of communications between communication terminals" operates. Applicant would like to point out to the Examiner that in the specification, page 2, lines 21-34 and page 3, lines 1-3; the specification is clearly enabling and that the claims do not contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to

which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, "the management device determines if a connection can be established between the calling user and a called user, before any communication attempt is undertaken, and without the calling user having to do anything". (See page 2, line 34 and page 3, lines 1-3). Applicant would also like to point out page 7, lines 9 through page 8, line 30 for further clarification of the claimed invention.

The invention proposes a management device (D), installed in a call server (CS) for example, of the private network (N), preferentially equipped with an access gateway (GW) charged with negotiation of connections in accordance with a communication protocol such as a Session Initiation Protocol (SIP) for example.

The management device (D) includes a memory in which is stored a table of correspondence between at least user identifiers and lists of at least one communication terminal identifier. A user identifier is composed of data representing, for example, a name or an alphanumeric code. In addition, the list associated with a user includes communication identifiers for each of its communication terminals. A terminal identifier is, for example, a telephone number or an IP address.

The management device (D) also includes a processing module (PM) which is charged, each time that it receives a call request from a calling user (Ui) for a called user (Uj), to access the memory (M) in order to extract the two lists of terminals which are associated with the calling (Ui) and called (Uj) users. Once the two lists have been extracted, the processing module (PM) attempts to determine from them, in accordance with at least one availability criterion, a calling terminal and a called terminal which are likely to establish a call between them which will satisfy the request of the calling user (Ui).

The call request can be placed by the calling user (Ui) by any means whatever, such as by voice control or by the selection of a menu on one of the known terminals, or on an interactive terminal located in his company, and then by supplying a called user name (Uj), or its identifier, by voice or by keyboard entry or by selection from a directory. In the above cases, the user terminal or the interactive terminal knows the communication identifier of the call server (CS) in which DEVICE D is installed, in such a manner that it is able to automatically establish the connection to the latter. However, it is also possible to envisage that the calling user (Ui) will himself dial the communication identifier of the call server (CS) in which the management device (D) is installed, with one of its terminals for example, or with any other communication terminal, and then communicates to said management device (D) its own user identifier and the identifier of the user to be called, either by keyboard entry or by voice control.

Several availability criteria can be used, either separately or in combination. Among these availability criteria, one can mention, in particular the

availability of terminals or the availability of resources of at least one of the communication networks within which communications can take place which satisfy the requirements of the calling user (Ui), or indeed the availability of memory resources of the calling terminal and/or the called terminal. Other availability criteria can also be envisaged, such as the computing time (CPU) necessary or the authorization to exchange a data type in accordance with a safety policy in the form of a firewall.

Accordingly, Applicant submits that the claims recite subject matter which is described in the specification in such a way as to enable one skilled in the art to make and/or use the invention. Thus, the Examiner is requested to withdraw the enablement rejection.

### **Claim Rejections - 35 USC § 102**

*Claims 1-3, 6-7, 21-22, 25 are rejected under 35 U.S.C 102(b) as being allegedly anticipated by Ono et al. (JP07-264298; hereinafter Ono). Applicant respectfully traverses these rejections.*

#### ***Claim 1***

Independent claim 1 now recites, in part:

a memory capable of storing the identifiers of users in correspondence with lists of at least one communication terminal identifier; and

processing means for, ***on receipt of a call request to a called user from a calling user***, accessing said memory in order to extract the lists of identifiers of terminals which are associated with the identifiers of said calling users and said called users, ***and then determining***, from said extracted lists, a calling terminal and a called terminal which is likely to establish a call between the calling terminal and the called terminal which satisfies said call request of said calling user, ***in accordance with at least one availability criterion***.

The Examiner asserts that element 2, drawings 4-7, the abstract, and paragraph [0007]-[0015] of Ono discloses all the features of claim 1. Applicant respectfully disagrees with the Examiner's position.

Ono discloses a correspondence procedure using a communication apparatus which has two or more network interfaces. (See paragraph [0007]). In Ono, "an origination side obtains information on an usable means of communication ***in advance*** of dispatch of a communication content by a destination side". (See paragraph [0007]). In the claimed invention, however,

“*on receipt of a call request* to a called user from a calling user, access[es] said memory in order to extract the lists of identifiers of terminals which are associated with the identifiers of said calling users and said called users, *and then determin[es]*, from said extracted lists, a calling terminal and a called terminal which is likely to establish a call between the calling terminal and the called terminal which satisfies said call request of said calling user”. It is thus clear in Ono, that information of usable means of communication are obtained in advance, and Ono fails to disclose or teach these features of claim 1.

Claim 1 also recites, in part, “a calling terminal and a called terminal which is likely to establish a call between the calling terminal and the called terminal which satisfies said call request of said calling user, *in accordance with at least one availability criterion*”.

Ono discloses, “a correspondence procedure which both an origination side and a destination side *show an addresser information* on an usable means of communication, and an addresser chooses either among shown means of communication”. (See paragraph [0007]). Thus, Ono teaches choosing means of communication based on “addresser information”, but does not disclose “a calling terminal and a called terminal which is likely to establish a call between the calling terminal and the called terminal which satisfies said call request of said calling user, *in accordance with at least one availability criterion*” as recited in the claimed invention.

Accordingly, claims 2-25 should be patentable over the prior art at least by virtue of their dependencies from claim 1.

***Claims 2, 3, 6, 7, 21, 22, and 25***

The Examiner asserts that element 2, drawings 4-7, abstract, and paragraphs [0007]-[0015] of Ono discloses all the features of claims 2, 3, 6, 7, 21, 22, and 25. Applicants respectfully disagree.

***Claim 2***

Ono discloses a means-of-communication database (see paragraph [0011]), but does not disclose “processing means determine said calling terminals and said called terminals” as recited in claim 2.

***Claim 3***

Claim 3 recites, in part, “said determined medium is configured to provide for the transmission of the ***greatest number of different types of data***”. Ono discloses, “usable means of communication are a telephone, a TV phone, a facsimile, and an E-mail”. (See paragraph [0012]). Ono, however, does not disclose this feature of claim 3.

***Claim 6***

Claim 6 recites, in part, “the communication which satisfies said request should take place via at least one communication network presenting ***a state of availability of resources***, wherein said processing means performs the determining in accordance with the state of availability of said communication network resources”. Similar to the arguments presented in claim 1, Ono does not disclose or teach, “***a state of availability of resources***”.

***Claim 7***

Claim 7 recites in part, “said ***processing means*** perform the determining in accordance with at least one other ***auxiliary criterion***”. As previously argued in claim 2, Ono fails to

disclose “processing means” as recited in claim 7. Furthermore, Ono fails to disclose or teach, “auxiliary criterion”.

***Claim 21 and 22***

Claim 21 and 22 recite the element, “processing means”. As previously argued in claim 2, Ono fails to disclose “processing means”.

**Claim Rejections - 35 USC § 103**

*Claims 4, 5, 8, and 9 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Ono in view of McKinnon et al. (US 2003/0135624: hereinafter “McKinnon”).*

*Claims 10-12 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Ono in view of Horvitz (WO 02/075495).*

*Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Ono in view of Weik (US 7,024,480).*

*Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Ono in view of Gessel (US 5,790,647).*

*Claims 17-18 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Ono in view of Thornton et al. (US 6,363,065; hereinafter “Thornton”). Applicant respectfully traverses these rejections.*

*Claims 19-20 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Ono in view of Khuc (US 6,470,008).*

*Claims 23-24 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Ono in view of Horvitz.*

***Claim 4***

Claim 4 recites in part, “said ***processing means*** perform the determining in accordance with ***a state of availability of said calling terminals and said called terminal***”. The Examiner concedes that Ono fails to disclose claim 4, but cites McKinnon as allegedly curing the deficiencies. Applicant respectfully disagrees with the Examiner’s position.

McKinnon discloses “the *presence function* 16 will recognize that the screen saver is not active (step 100) and create service logic based on the fact *that User X is present* at the PC”. (See paragraph [0029]). McKinnon bases its determination based on whether the User is present at the PC, but does not disclose, “said processing means perform the determining in accordance with *a state of availability of said calling terminals and said called terminal*”. Thus, Ono and McKinnon, alone or combination, fails to disclose or teach all elements of claim 4.

***Claim 5***

Claim 5 recites, “state of availability of said communication terminal identifiers”. For the same reasons that claim 4 is patentable over the prior art, claim 5 is also patentable over the prior art.

***Claim 8-14***

Claims 8-14 should be patentable over the prior art at least by virtue of their dependencies from claim 1.

***Claims 15 and 16***

Claim 15 recites, in part, “processing means perform the determining in accordance with the hierarchical level of the calling and/or called users, wherein said hierarchical level comprises auxiliary criterion”. The Examiner concedes that Ono does not disclose this feature, but cites Gessel as allegedly disclosing this feature. Applicant respectfully disagrees with the Examiner’s position.

Gessel discloses “if a subscriber wishes to have the “cancel call waiting feature” activated whenever her boss calls her, the telecommunications exchange automatically actives that feature before establishing a connection with her.” (See col. 3, lines 55-58). Activating call waiting as described in Gessel, however, does not disclose, “processing means perform the

determining in accordance with the hierarchical level of the calling and/or called user hierarchical level of the calling and/or called user”. Thus, Ono and Gessel, alone or in combination does not disclose all the features of claim 15.

Accordingly, for the same reasons that claim 15 is patentable over the prior art, claim 16 is also patentable over the prior art.

***Claims 17 and 18***

Claim 17 recites, in part, “wherein said processing means perform the determining in accordance with geographical location information of the calling and/or called users, and the topology of at least one communication network in which said communication must take place, wherein said geographical location constitutes an auxiliary criterion.” The Examiner concedes that Ono does not disclose all the features of claim 17, but cites Thornton as curing the deficiencies of Ono.

Thornton disclose, “selective call routing to route, based on called directory numbers”. (See col. 6, lines 62-63). Thornton, however, does not disclose, “wherein said processing means perform the determining in accordance with ***geographical location information*** of the calling and/or called users, and ***the topology*** of at least one communication network in which said communication must take place” as recited in the claimed invention. Thus, Ono and Thornton, alone or in combination do not disclose all the features of claim 17.

Accordingly, for the same reasons that claim 17 is patentable over the prior art, claim 18 is also patentable over the prior art.

***Claims 19 and 20***

Claim 19 recites in part, “wherein said processing means perform the determining in accordance with connection resource availability information of at least one communication

network in which said communication must take place, constituting an auxiliary criterion.” And claim 20 recites, in part, “wherein said processing means transmits to said calling user data which are representative of the medium determined for said call”. The Examiner concedes that Ono does not disclose all the features of claims 19 and 20, but cites Khuc as curing the deficiencies of Ono.

Khuc discloses, “the routing system can select internet addresses based upon the availability of internet gateways provided by the routing system or by other service providers”. (See col. 2, lines 35-38). As can be seen in Khuc, the routing system does not take into account that “said communication must take place” as recited in claim 19. Furthermore, Khuc does not disclose or teach, “data which are representative of the medium” as recited in claim 20. Thus, Khuc and Ono, alone or in combination, do not disclose, “wherein said processing means perform the determining in accordance with connection resource availability information of at least one communication network *in which said communication must take place*” and “wherein said processing means are arranged to transmit to said calling user data which are representative of the medium determined for said call”.

***Claim 23***

Claim 23 recites, in part, “processing means orders said establishment in the event of receiving an authorization from said calling user and or said called user”. The Examiner asserts “established preferences that indicate that for communications from first group of contractors”; “second group of contractors”; or “third group of contractors” as cited in Horvitz discloses the above recited features. (See page 24, lines 22-34). Horvitz, however, discloses that based on the “established preferences” communication is either “email” or “real-time phone communications” depending on contactee’s preferences. (See page 24, lines 22-34). Thus, Horvitz and Ono, alone

or in combination, do not disclose or teach “processing means orders said establishment in the event of receiving an authorization from said calling user and or said called user” as recited in the claimed invention.

***Claim 24***

Claim 24 recites, in part, “wherein said processing means determines another called terminal, and able to establish another call between them to satisfy said request, and/or another communication medium, in the event that it is not possible to establish said communication”. The Examiner asserts “established preferences that indicate that for communications from first group of contractors”; “second group of contractors”; or “third group of contractors” as cited in Horvitz discloses the above recited features. (See page 24, lines 22-34). Horvitz, however, discloses that based on the “established preferences” communication is either “email” or “real-time phone communications” depending on contactee’s preferences. (See page 24, lines 22-34). Horvitz, does not disclose or teach, “wherein said processing means determines another called terminal, and able to establish another call between them to satisfy said request, and/or another communication medium, in the event that it is not possible to establish said communication”. Thus, Horvitz and Ono, alone or in combination do not disclose or teach all the features of claim 24.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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Date: June 20, 2008